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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,184	03/14/2001	Kenji Ohshima	Q63509	2848
23373	7590	09/02/2004		
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER BRUENJES, CHRISTOPHER P	
			ART UNIT 1772	PAPER NUMBER

DATE MAILED: 09/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/805,184

Applicant(s)

OHSHIMA ET AL.

Examiner

Christopher P Bruenjes

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1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) 7-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 2, 2004 has been entered.

WITHDRAWN REJECTIONS

2. The 35 U.S.C. 103 rejections of claims 1, 2, 4, 5, and 18-20 over Roder of record in the Office Action mailed April 2, 2004, Pages 7-9 Paragraph 13, and the Office Action mailed November 6, 2003, Pages 11-13 Paragraphs 11-12, have been withdrawn due to Applicant's amendments in the Paper filed July 2, 2004.

3. The 35 U.S.C. 103 rejections of claims 3 and 6 over Roder in view of Adams of record in the Office Action mailed November

6, 2003, Pages 9-11 Paragraph 10, have been withdrawn due to Applicant's amendments in the Paper filed July 2, 2004.

REPEATED REJECTIONS

4. The 35 U.S.C. 102 rejections of claims 1, 2, 4, 5, and 19 as anticipated by Kewin are repeated for the reasons previously of record in the Office Action mailed April 2, 2004, Pages 5-6 Paragraph 12.

Regarding the newly added limitation of claim 1, Kewin does not teach the target having any electrical components.

5. The 35 U.S.C. 103 rejections of claims 3 and 6 over Kewin in view of Adams are repeated for the reasons previously of record in the Office Action mailed April 2, 2004, Pages 10-11 Paragraph 15.

Regarding the newly added limitation of claim 1, Kewin does not teach the target having any electrical components.

6. The 35 U.S.C. 103 rejection of claim 20 over Kewin is repeated for the reasons previously of record in the Office Action mailed April 2, 2004, Pages 9 Paragraph 14.

Regarding the newly added limitation of claim 1, Kewin does not teach the target having any electrical components.

NEW REJECTIONS

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35

U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-6 and 19-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original specification fails to reasonably convey to one skilled in the relevant art that the target is "not provided with electrical components." Although the specification does not mention that electrical components are provided in the target, it also never mentions that electrical components are not provided in the target. The specification broadly states that the target is configured to provide information to identify

the type of said sheet roll, but never states that this configuration is not in the form of electrical components.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 2, 4, 5, and 20 are rejected under 35

U.S.C. 102(e) as being anticipated by Oshima (USPN 6,390,428).

Oshima anticipates a printable stencil sheet roll cartridge (see abstract) comprising a sheet rolled in a tubular manner to form a sheet roll (reference number R, Fig. 1) having a hollow portion (reference number 14, Fig.1) therein. The cartridge further contains a core tube (reference number 16, Fig.1) disposed in the hollow portion and a target (reference number 15, Fig.1) disposed in the core tube. The target is configured to provide information to identify the type of said sheet roll so that the sheet roll of the correct material, thickness,

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width, or quantity of winding, or sensitivity of the material is the only sheet roll that can be placed in the stencil machine (col.1, 1.36-39 and col.1, 1.53-57). The target has no electrical components. The target has an opening formed therein because the target is a tube with an opening in the middle (see reference number 15, Fig. 1). The target is located at one of a plurality of predetermined positions such as flush with the end of the tube (col.3, 1.36-38) or internally with respect to the end of the tube (col.3, 1.63-67). The predetermined position of the target is used to determine the type of sheet roll because depending on whether the target is placed flush or internally of the edge of the tube will determine if the sheet roll will fit the complementary collar.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oshima (USPN 6,390,428) in view of Adams et al (USPN 4,852,823).

Oshima teaches all that is claimed in claim 1, but fails to teach that the target is colored one of a plurality of predetermined colors. However, Adams et al teach that the type of sheet or yarn roll is determined by coloring a "target" one of a plurality of predetermined colors (col.3, 1.20-47). Adams et al specifically teaches that the color of the "target" is an indicium for a particular characteristic of the yarn, such as the type of yarn, or the source, etc. Therefore, Adams et al teaches that the color of the "target" is used to teach the characteristics or type of the yarn roll, just as Oshima teaches that the "target" is used to teach the characteristics or type of the sheet roll.

One of ordinary skill in the art would have recognized that Adams et al is analogous to Oshima, because the inventions are similar in structure and function. Both a bobbin for yarn and a core for a sheet roll are structurally similar as tube for wrapping a sheet around it and functionally they are both used to roll and unroll sheets of material. Also, it has been held that in a simple mechanical invention a broad spectrum of prior art must be explored and it is reasonable to permit inquiry into other areas where one of ordinary skill in the art would be aware that similar problems exist. One of ordinary skill in the art would have recognized that bobbins would have the same problem of determining what type of material is wrapped around the bobbin.

One of ordinary skill in the art would have also recognized that the color scheme of Adams et al is another equivalent method of identifying the type of said sheet roll as Oshima's target, and that the target of Oshima would be colored to give a quick visual indication of the type of sheet roll, as taught by Adams et al along with the information provided by the location of the target.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the applicant's invention was made to color the target of Oshima one of a plurality of

predetermined colors, in order to provide the sheet roll with a quick visual indication of the type of sheet roll, as taught by Adams et al.

ANSWERS TO APPLICANT'S ARGUMENTS

10. Applicant's arguments regarding the 35 U.S.C. 102 rejections of claims 1, 2, 4, 5, and 19 as anticipated by Kewin have been fully considered but they are not persuasive.

In response to Applicant's argument, regarding claim 1, that Kewin fails to teach that the target inherently is configured to provide information to identify the type of said sheet roll as "type" is defined in the claims, Kewin teaches a collar that is inserted into a tubular core for a roll of paper. The target is mated to complement a plug so that if the wrong paper roll is used it will not mate with the plug and therefore could not be used. Therefore, the target of Kewin has a particular configuration that enables one of ordinary skill in the art to identify if the sheet roll is correct for the machine. If the target has a different configuration it would not fit the plug and one of ordinary skill in the art would be able to identify that that particular sheet roll is incompatible with the apparatus. As stated by the applicant in past remarks, the limitation "configured to provide information to identify

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the type of said sheet roll" is a functional limitation in an article claim. Although as stated by the applicant, functional limitations must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art, claims directed to an apparatus or article must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114. In this case, the target of Kewin has the same structural limitations as determined by the instant specification as the target of the instant invention with regards to both being a disc-like object. Apparatus claims cover what a device is, not what a device does. See MPEP 2114. In this case, the target of Kewin meets all of the structural limitations of the claimed target and has the ability to perform the function of identifying the type of sheet roll by whether or not the target will fit in the plug. Therefore, Kewin is inherently configured to provide information to identify the type of said sheet roll as claimed in claim 1.

In response to Applicant's argument that claims 2, 4, and 5 are patentable over Kewin by virtue of their dependency on claim 1, see the arguments regarding the rejection of claim 1 over Kewin above.

In response to Applicant's argument that claim 19 is patentable over Kewin for analogous reason as claim 1, see the arguments regarding the rejection of claim 1 over Kewin above.

11. Applicant's arguments regarding the 35 U.S.C. 103 rejections of claims 1, 2, 4, 5, and 18-20 over Roder have been considered but they are moot since the rejections have been withdrawn.

12. Applicant's arguments regarding the 35 U.S.C. 103 rejection of claim 20 over Kewin have been fully considered but they are not persuasive.

In response to Applicant's argument that claim 20 is patentable over Kewin by virtue of its dependency on claim 1, see the arguments regarding the rejection of claim 1 over Kewin above.

13. Applicant's arguments regarding the 35 U.S.C. 103 rejections of claims 3 and 6 over Kewin in view of Adams have been fully considered but they are not persuasive.

In response to Applicant's argument that claims 3 and 6 are patentable over Kewin by virtue of their dependency on claim 1,

see the arguments regarding the rejection of claim 1 over Kewin above.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P Bruenjes whose telephone number is 571-272-1489. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Christopher P Bruenjes

Examiner

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CPB

August 26, 2004

Nasser Ahmad
NASSER AHMAD
PRIMARY EXAMINER
Acting SPE

8/27/04